

### **REMARKS**

In response to the Office Action mailed June 13, 2008, Applicant respectfully requests reconsideration. To further the prosecution of this application, amendments have been made in the claims, and each of the rejections set forth in the Office Action had been carefully considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 114-125 and 196-219 were previously pending in this application. Claims 114-125 and 196-212 are amended. Claims 213-219 are canceled. Claims 220-251 are added. As a result, claims 114-125, 196-212 and 220-251 are pending for examination, with claims 114, 212, 221 and 249 being independent. No new matter has been added.

### **Restriction Requirement**

The Office Action contends that claims 213-219, which were added in Applicant's previous response filed February 26, 2008, are independent and distinct from the claims previously presented. The Office Action indicates that claims 114-125 and 196-212 have been constructively elected by original presentation for prosecution, and that claims 213-219 are withdrawn from consideration as being directed to a non-elected invention.

Applicant confirms the constructive election of claims 114-125 and 196-212. Withdrawn claims 213-219 have been canceled.

### **Claim Objections**

Claim 211 is objected to for purportedly being of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, the Office Action contends that the phrase "if consent is deemed to not be given by the user" recited by claim 211 conflicts with the phrase "once the consent is deemed given" recited by claim 114, from which claim 211 depends.

Claim 211 is amended herein to depend from claim 212 rather than claim 114. Claim 212 recites "if consent is deemed given by the user." Claim 211 does not conflict with claim 212, as the conditional phrase "if consent is deemed to not be given by the user" recited by claim 211 merely

recites acts which are performed if the condition provided by claim 211 (i.e., the alternative to the condition provided by claim 212) is satisfied. Accordingly, Applicant respectfully requests that the objection to claim 211 be withdrawn.

#### Claim Rejections Under 35 U.S.C. §101

Claims 114-125 and 196-212 are rejected under 35 U.S.C. §101 for purportedly being directed to non-statutory subject matter. Specifically, the Office Action contends that the method recited by each of claims 114 and 212 fails to produce a useful, concrete and tangible result.

Without acceding to the propriety of the rejection, each of independent claims 114 and 212 is amended herein to recite at least one computer-readable medium encoded with instructions which, when executed, perform a method. MPEP §2106.01 makes clear that the subject matter to which each of claims 114 and 212 is directed is statutory under §101. In particular, MPEP §2106.01 provides that “functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component,” and that “when functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” As each of independent claims 114 and 212 is directed to at least one computer-readable on which functional descriptive material is encoded, each of claims 114 and 212 is directed to subject matter that is statutory under §101.

Accordingly, Applicant respectfully requests withdrawal of the rejection of each of independent claims 114 and 212, and of the claims that depend respectively therefrom, under 35 U.S.C. §101 for purportedly being directed to non-statutory subject matter.

#### Claim Rejections Under 35 U.S.C. §112

Claims 114 and 115 are rejected under 35 U.S.C. §112, second paragraph, for purportedly being indefinite. Specifically, the Office Action contends that the meaning of claim 115 is unclear

in light of claim 114, from which claim 115 depends. In this respect, claim 114 recites enabling delivery of information to a user once consent is deemed given by the user, and claim 115 recites receiving the consent. The Office Action questions how consent could be deemed given by the user unless it has been received.

Applicant respectfully points out that deeming a user's consent to have been given does not require receiving the user's consent, and that there are many ways to determine whether consent has been given without actually receiving consent from the user. As a result, claim 115 is not indefinite in light of claim 114, so that Applicant respectfully requests withdrawal of the rejection of claims 114 and 115 under 35 U.S.C. §112, second paragraph.

#### Claim Rejections Under 35 U.S.C. §102

Each of independent claims 114 and 212 is rejected under 35 U.S.C. §102(b) as purportedly being anticipated by U.S. Patent No. 6,192,407 to Smith ("Smith"). Each of independent claims 114 or 212 is amended herein, and patentably distinguishes over Smith.

#### A. Claims 114-125 and 196-211

As amended herein, claim 114 recites at least one computer-readable medium encoded with instructions which, when executed, perform a method. The method comprises, before making information available to a user, requesting consent of the user to electronic delivery of the information; and once the consent is deemed given by the user, enabling the delivery of the information to the user.

Smith fails to satisfy all of the limitations recited by claim 114, as Smith fails to disclose or suggest requesting consent of a user to electronic delivery of information *before making the information available to the user*.

Smith discloses a system for distributing information to each of a number of recipients using a "private uniform resource locator" (PURL) (Abstract). Specifically, a PURL uniquely identifies an intended recipient, one or more documents to be delivered, and various parameters (Abstract). A

document delivery system which employs PURLs is depicted in FIG. 20 (col. 15, lines 28-30). The system includes a sender 300 who forwards a document 310 to a server 315, which stores the document and generates a PURL for each intended recipient (col. 15, lines 30-33). The server encodes information relating to the user, document, delivery and transaction identifiers within the PURL (col. 15, lines 33-37). Each PURL is then forwarded via email to an intended recipient, so that the recipient is notified that a document has been sent to him/her (col. 15, lines 37-40). Using the PURL, the recipient may access the document (col. 15, lines 40-41).

In the system of Smith, no request is made for the user's consent to electronic delivery of information before the information is made available to the user, as required by claim 114. Rather, in the system of Smith, information is emailed to the user without any prior request for the user's consent to do so. Even if one considered the "information" to be the document which the user may access by clicking on a PURL provided in the email, in the system of Smith this "information" is made available at the same time the user's request to electronically deliver it is requested (i.e., when the email containing the PURL, through which the document may be accessed, is delivered to the user). As a result, Smith does not disclose or suggest requesting a user's consent to electronic delivery of information *before making the information available to the user*, as required by claim 114.

In the "Response To Arguments" section, the Office Action includes a contention which Applicant would like to address. Specifically, the Office Action contends that Smith discloses an intended recipient taking action prior to receiving a document which "demonstrate[s] the recipient's consent or acquiescence to the delivery of information," and cites several passages of Smith (i.e., col. 13, lines 19-32 and col. 13, line 58 – col. 14, line 4) in support of this contention. Neither of the cited passages provides any support for the Office Action's contention.

At col. 13, lines 19-32, Smith discloses functionality which enables the sender of a document to customize various delivery parameters, such as security options and receipt requirements (col. 13, lines 19-32). For example, the sender may specify whether the document should be encrypted using private or public key encryption, or whether the sender should be notified when the document is received by an intended recipient (col. 13, lines 26-32). This passage is

exclusively directed to functionality employed by the sender of a document, and thus discloses or suggests nothing that “demonstrate[s] the recipient’s consent or acquiescence to the delivery of information,” as the Office Action contends.

At col. 13, line 58 – col. 14, line 4, Smith discloses that a recipient may retrieve software (i.e., PDRC 194; FIG. 16) to open documents that are sent to the recipient in a particular format (col. 13, lines 58-63). Specifically, if the user does not already possess appropriate software for opening a received document, the user may then download the software to provide the capability to open the document (col. 13, line 63 – col. 14, line 4). This passage thus relates to a user acquiring software to open a document *after the document has arrived*, and has nothing to do with “demonstrat[ing] the recipient’s consent or acquiescence to the delivery of information,” as the Office Action contends. Specifically, at the time the user retrieves the software, the information has already been delivered, and the information has already been made available. By contrast, claim 114 requires requesting consent of a user to electronic delivery of information *before the information is made available to the user*.

Accordingly, claim 114 patentably distinguishes over Smith, such that the rejection of claim 114 under 35 U.S.C. §102(b) as purportedly being anticipated by Smith should be withdrawn.

Claims 115-125 and 196-211 depend from claim 114 and are patentable for at least the same reasons.

B. Claim 212

Claim 212 recites at least one computer-readable medium encoded with instructions which, when executed, perform a method comprising: before making information available to a user, requesting consent of the user to electronic delivery of the information; and if consent is deemed given by the user, enabling the delivery of the information to the user.

It should be appreciated from the discussion above relating to independent claim 114 that Smith fails to disclose or suggest requesting consent of a user to electronic delivery of information

before providing the user access to the information, and if consent is deemed given by the user, enabling the delivery of the information to the user, as required by claim .

Accordingly, claim 212 patentably distinguishes over Smith, such that the rejection of claim 212 under 35 U.S.C. §102(b) as purportedly being anticipated by Smith should be withdrawn.

### Claim Rejections Under 35 U.S.C. §103

Each of independent claims 114 and 212 is rejected under 35 U.S.C. §103(a) as purportedly being obvious over Smith. Applicant respectfully traverses these rejections.

The Office Action bases the rejection of independent claims 114 and 212 as purportedly being obvious entirely on Official Notice which is taken that “it is old and well-known for businesses and organizations to require that before providing access to information, requesting [sic] consent of a user to the electronic delivery of the information; and once the consent is deemed given by the user, enabling the delivery of the information to the user.” The rejection is improper for at least two reasons.

First, MPEP §2144.03 explicitly states that it is never appropriate to rely on Official Notice as the principal basis for a rejection, let alone the sole basis, as it is here. The Office Action simply alleges that the claims are directed to subject matter that is old and well-known, but provides absolutely no evidentiary support for this contention. This is clearly improper, and the rejection should be withdrawn for at least this reason.

In addition, MPEP §2144.03 also provides that Official Notice should only be taken “where facts which are purportedly well known or common knowledge in the art are *capable of instant and unquestionable demonstration* as being well known” (emphasis added). Applicant respectfully points out that this is clearly not the case here, as even the Smith reference asserted in rejecting the claims under §102 fails to satisfy all of the claim limitations, as discussed above. Clearly, these purported “facts” are not susceptible to instant and unquestionable demonstration, as the Smith reference demonstrates that it is not old and well-known for businesses and organizations to, before making information available, request consent of a user to electronic delivery of the information. If

the rejection of claims 114 and 212 under §103 is to be maintained, Applicant respectfully requests that documentary evidence be provided which supports the Office Action's assertion that the claimed subject matter is "old and well-known."

In view of the foregoing, Applicant respectfully requests withdrawal of the rejection of each of claims 114 and 212, and of the claims that depend respectively therefrom, under 35 U.S.C. §103(a) as purportedly being obvious.

### New Claims

New claims 220-251 are added to further define Applicant's contribution to the art.

Claim 220 depends from claim 114, and is patentable for at least the same reasons as those discussed above with reference to claim 114.

Independent claim 221 is directed to a system comprising at least one processor programmed to: before making information available to a user, request consent of the user to electronic delivery of the information; and once the consent is deemed given by the user, enable the delivery of the information to the user. As discussed above with reference to claim 114, the prior art of record does not disclose or suggest requesting consent of a user to electronic delivery of information before making the information available to the user, and enabling delivery of the information to the user once the consent is deemed given. Accordingly, independent claim 221 patentably distinguishes over the prior art of record.

Each of claims 222-248 depends from claim 221 and is allowable for at least the same reasons as claim 221.

Independent claim 249 is directed to a system comprising at least one processor programmed to: before making information available to a user, request consent of the user to electronic delivery of the information; and if consent is deemed given by the user, enable the delivery of the information to the user. As discussed above with reference to claim 212, the prior art of record does not disclose or suggest requesting consent of a user to electronic delivery of information before making the information available to the user, and enabling delivery of the information to the user if

consent is deemed given. Accordingly, independent claim 248 patentably distinguishes over the prior art of record.

Each of claims 250-251 depends from claim 249 and is allowable for at least the same reasons as claim 249.



**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. N0389.70006US00.

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Respectfully submitted,

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